

REMARKS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided. Upon entry of the above amendment, claims 1, 19, 22 and 29-31 will have been amended, claims 6-8 will have been canceled, and claims 33-37 will have been added. Claims 1, 3-5, 9-10, 12-19, 21-23, 25-31 and 33-37 are pending for consideration by the Examiner. Applicant notes that newly added claims 33-37 correspond to independent claims 1, 19 and 29-31, but have clarified “character type” as “font” by reciting that the font, rather than the color, is used for the claimed differentiation feature. Applicant respectfully requests reconsideration of the outstanding rejections and allowance of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

The Examiner has rejected claims 1, 3-12, 16-18, 24 and 29-30 under 35 U.S.C. § 103(a) as being over U.S. Patent No. 4,846,155 to KIMURA in view of U.S. Patent No. 4,044,546 to SATO¹, finding that KIMURA teaches all of the limitations of the above claims except for the teaching of color code or character type being different from the others. However, the Examiner has determined that SATO teaches displaying dates and months each

¹ Applicant notes that claims 11 and 24 were canceled in a previous response. However, Applicant assumes that the Examiner’s rejection of these two claims is a result of the Examiner “cutting and pasting” from a previous official action, and that these claims are indeed canceled. Applicant requests confirmation in this regard, should Applicant’s understanding be incorrect.

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in a different color, and concludes that it would have been obvious to include this feature into the device of KIMURA.

With respect to the Examiner's rejection of independent claims 1 and 29-30, Applicant respectfully traverses this rejection, and submits that the applied references are markedly different from the present invention as claimed. Specifically, the applied references fail to teach or suggest the displaying of the date in an order of at least one of year, month and day; month, day and year; and day, month and year, wherein one of the year, month, and day is set to a color different from the others, as claimed in independent claims 1, 19 and 29-31. The applied references further fail to teach or suggest the displaying of the date in an order of at least one of year, month and day; month, day and year; and day, month and year, wherein one of the year, month, and day is set to a font different from the others, as claimed in newly-added independent claims 33-37.

For example, in the Official Action, the Examiner asserted that this "date-differentiating" feature is present in KIMURA, but does not explain how the year, month and day are differentiated on the screen without a different character type or color (this different character type/color feature not being taught by KIMURA, as correctly noted by the Examiner). Thus, if the date in KIMURA is displayed as "01-10-03", without making the font or color different, there is no way to distinguish the date from January 10, 2003, October 3, 2001, or March 10, 2001. However, in the present invention of claims 1-31, for example,

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if the color of the year is set in red, and the month is set in blue, then one reading the date would understand it to be October 3, 2001, no matter which date-order convention is used in the world. Similarly, with respect to newly added claims 33-37, for example, setting the font of the year in `courier new` and setting the font appearance of the month in `arial` (*i.e.*, 01-10-03), then one reading the date would also understand the date as well. Further, changing the font, for example, boldfacing the year and italicizing the month (*i.e.*, **01-10**-03) would also enable one reading the date to understand it as well (*see, e.g.* Fig. 19 of the present application).

Applicant further traverses Examiner Kelley's determination, during the interview, that color is a type of font. In response, Applicant invites the Examiner to review the definition of "font" as defined in *Webster's New Collegiate Dictionary*, a copy of which is enclosed, which defines "font" as "an assortment or set of type all of one size and style." Thus, color is not part of a font, as one could have a single font in various colors, so long as they are in the same size and style. For further understanding of "font style" the Examiner is invited to look at the "font" menu in either or both Microsoft Word 2000 or WordPerfect 6.1, which includes, *e.g.*, italics and boldface as the font style.

Further, Applicant notes that the applied SATO secondary reference is directed to displaying the date at an arbitrary position (*see, e.g.*, Fig. 3E), and while this reference discloses displaying the *entire* date in different colors (*see, e.g.*, col. 10, lines 40-51), there

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appears to be no disclosure whatsoever in SATO of differentiating the date by setting one of a year, month and day to a color or font different from the others.

Applicants further respectfully submit that the Examiners are mistaken in their assertion that the claimed feature setting one of the year, month, and day to a color or font different from the others “lacks criticality.” To the contrary, and as noted in Applicant’s Appeal Brief, different parts of the world display the date in different order. For example, January 10, 2003 is displayed in the United States as 01-10-03, is displayed in Japan as 03-01-10, and is displayed in parts of Europe as 03-10-01. Given the international nature of medicine, as in certain instances medical records and procedures may be viewed in several countries to effect treatment, it is crucial that a doctor or other medical professional viewing the display in any given country, be given accurate information as to when a particular procedure was performed, for example, to track the progression of a disease. For example, a Japanese doctor viewing an image recorded from overseas may not know whether 01-10-03 designates January 10, 2003, October 3, 2001, or March 10, 2001.

To the contrary, the endoscope of KIMURA merely displays the date on the screen (as noted by the Examiner in, *e.g.*, Fig. 15), and does not differentiate at least one of the day, month and year from each other. Thus, a doctor viewing the display of KIMURA may be confused as to which digits represent the year, month or day of the date, as described *supra*.

Further, regarding Examiner's assertion that the claimed invention "lacked criticality," even assuming *arguendo* that the Examiner's application of the applied references is reasonable, an Examiner may not dismiss, as Examiner Kelley has in the interview of December 4, an explicit claim limitation by stating that it "lacks criticality." The record is clear as to the benefits of displaying one of the day, month and year in a different color or font. Accordingly, the disputed limitation is indeed critical. In any event, lack of "criticality" is not a measure of obviousness of a claim.

Thus, Applicant respectfully submits that these independent claims are patentably distinct from the references of record.

Moreover, Applicant respectfully submits that the Examiner has not set forth a proper motivation as required by 35 U.S.C. § 103 to combine the teachings of KIMURA and SATO in the manner asserted by the Examiner. It is clear that in both rejections under §103, the Examiner has, based upon Applicant's disclosure, picked various individual features of the references and has combined them in the manner taught only by Applicant's disclosure. This hindsight reconstruction of the prior art is inappropriate under 35 U.S.C. § 103.

Applicant submits that rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation,

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unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis.

See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is therefore submitted that for at least the above reasons, claims 1, 3-10, 12, 16-18, 29-31 and 33-35 are patentable over the references of record.

The Examiner has rejected claims 13-15, 19, 21-23, 25-28 and 31 under 35 U.S.C. § 103(a) as being over KIMURA in view of SATO and further in view of U.S. Patent No. 5,408,996 to SALB, finding, regarding claims 13, 14, 19 and 26, that KIMURA and SATO teach all of the limitations of the above claims except for the storing processor that stores the date along with the object image as a single image. However, the Examiner has determined that SALB teaches displaying dates and the object image as a single image, and concludes that it would have been obvious to include this feature into the combination KIMURA and SATO.

Applicant respectfully traverses the Examiner's rejection for at least the reasons discussed *supra*. For example, the applied references fail to teach or suggest a storing processor that differentiates at least one of year, month and day of the date, as claimed in

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independent claim 19. As discussed *supra*, there is no disclosure in KIMURA of differentiating one of the year, month and day of the date, and single-color display of SATO is incapable of differentiating a date. Thus, Applicant respectfully submits that independent claims 19 and 31, as well as all independent claims, are patentably distinct from the references of record for at least these reasons.

Additionally, with respect to the Examiner's rejection under 35 U.S.C. § 103(a) (based on KIMURA in view of SATO and further in view of U.S. Patent No. 5,408,996 to SALB), the Examiner has again not set forth a proper motivation as required by 35 U.S.C. § 103 to combine the teachings of the references in the manner asserted by the Examiner, as it appears that the Examiner has taken the above-noted improper (KIMURA-SATO) combination and again inappropriately and randomly combined it with another reference (SALB), to arrive at the invention as recited in Applicant's claims 13-15, 19, 21-23, 25-28 and 31.

Additionally, while the Examiner has correctly asserted that KIMURA and SATO fail to teach a storing processor that stores the date along with the object image as a single image, the Examiner has failed to assert that SALB teaches such a claimed storing limitation. Rather, the Examiner has asserted that SALB teaches displaying dates and the object image as a single image. Applicant notes that while SALB may appear to store and display the object image, SALB completely fails to disclose the claimed storing processor that stores the date along with the object image in an image storage device as a single image, as claimed in

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independent claim 19. In fact, SALB completely fails to disclose the storing of dates at all. Thus, no proper combination of SATO, KIMURA and SALB can render unpatentable the combination of features recited in at least independent claims 19 and 31.

With respect to the Examiner's rejection of dependent claims 3-18, 21-24 and 25-28 under 35 U.S.C. §103(a), as claims 6-8 have been canceled and claims 11 and 24 were canceled in a previous response, and the remaining claims are dependent from either allowable claim 1 or 19, the independent claims being allowable for at least the reasons discussed *supra*, these pending dependent claims are also allowable. Further, all dependent claims each set forth a further combination of elements neither taught nor disclosed by the applied references. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. §103(a).

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103 and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipate or render obvious Applicant's invention. In addition, the applied references of record have been discussed and distinguished, while significant features of the present invention have been pointed out. Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the subject matter argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's amendment is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
T. TAKAHASHI

William Boshnick
Reg. No. 44,550

Bruce H. Bernstein
Reg. No. 29,027

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191